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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,044	10/31/2003	Matthew Murray Williamson	1509-460	9711

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EXAMINER	
HENEGHAN, MATTHEW E	
ART UNIT	**PAPER NUMBER**
2134	
MAIL DATE	**DELIVERY MODE**
07/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/697,044	WILLIAMSON ET AL.	
	Examiner	Art Unit	
	Matthew Heneghan	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *15-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14,21-23 and 25-29* is/are rejected.

7)☒ Claim(s) *24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 October 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/31/04,5/27/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-14 and 20-29 in the reply filed on 2 May 2007 is acknowledged. The traversal is on the ground(s) that Group II should not be classified in Class 709. This is not found persuasive because the only independent claim of that group, claim 15, teaches to the delaying of transmission for ANY reason, rather than strictly for network security. As evidence of the proper classification of claim 15, attention is called to exemplary patents, all in Class 709, that teach to data transmissions being delayed for a reason. See U.S. Patents Nos. 5,378,067; 5,574,934; and 5,815,667.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-14 and 20-29 have been examined.

3. In claim 21, the word "includes" is being treated as the transitional phrase.

Priority

4. The instant application claims priority to Great Britain Patent Application No. 0309856.3, filed 29 April 2003.

Information Disclosure Statement

5. The following Information Disclosure Statements in the instant application have been fully considered:

IDS filed 31 March 2004.

IDS filed 27 May 2004.

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: item 720 in figure 7 and item 1414 in figure 14. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

7. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code in paragraph 23. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP §608.01.

Claim Objections

8. Claim 22 is objected to because of the following informalities: The claim lacks a transitional phrase. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

> only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 21-23, 25, 26, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,096,498 to Judge.

As per claims 21-23, Judge discloses a system in which a whitelist (a list of those nodes with which contact is permitted) is constructed by monitoring interactions by a node, using parameters such as outbound email addresses, with other hosts over an initial period (see column 26, lines 1-7), whitelisting those nodes contacted more than a certain number of times. Further transactions are checked against the whitelist and those appearing on the list may be exempted from further countermeasures (see column 25, lines 7-23). Countermeasures may include throttling the number of communications with non-whitelisted nodes per unit time (see column 31, lines 17-19).

As per claims 25 and 26, requests may be quarantined (stored for later processing) as a countermeasure (see column 31, line 15).

Regarding claim 29, Judge's system may be instantiated on a network having multiple nodes (see figure 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,096,498 to Judge as applied to claim 26 above, and further in view of U.S. Patent Application Publication No. 2003/0023875 to Hursey et al.

Judge does not discuss the manner in which the quarantine is to be maintained.

Hursey discloses a quarantine procedure in which quarantined messages are placed in a queue. In queue structures, the items are, by default, stored in the order in which they were enqueued (temporal order). Hursey discloses further testing of the queue members in light of subsequent messages, and pops items from the queue (effectively moving them to the front of the queue) if further processing is found to be necessary, with some queue members be popped and transmitted on a per unit time basis (see paragraphs 37-39). This is done to address the problem of mass mailed malware that is a sequence of separate email messages (see paragraph 17).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Judge by using Hursey's quarantine methods, to address the problem of mass mailed malware that is a sequence of separate email messages.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-15, 21-23, and 25-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/457,091 in view of U.S. Patent No. 7,096,498 to Judge further in view of U.S. Patent Application Publication No. 2003/0023875 to Hursey et al.

Claims 1 of the '091 application discloses the first two limitations of claim 1 of the instant application, but does not claim an additional section process.

Judge discloses a whitelisting process for selection, as described above, in order to avoid using time to scrutinize trusted nodes.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the claim of the '091 application as per Judge, in order to avoid using time to scrutinize trusted nodes.

Claims 2-15, 21-23, and 25-29 are likewise obvious over the '091 application in view of Judge and Hursey for the reasons stated above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claim 1-15, 21-23, and 25-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 10/687,694 in view of U.S. Patent No. 7,096,498 to Judge further in view of U.S. Patent Application Publication No. 2003/0023875 to Hursey et al.

All of the limitations of claim 1 of the instant application are claimed in claim 3 of the '694 application. Claims 2-15, 21-23, and 25-29 are obvious over the '694 application in view of Judge and Hursey for the reasons stated above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claim 1-15, 21-23, and 25-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 10/697,645 in view of U.S. Patent No. 7,096,498 to Judge further in view of U.S. Patent Application Publication No. 2003/0023875 to Hursey et al.

All of the limitations of claim 1 of the instant application are claimed in claim 14 of the '6454 application. Claims 2-15, 21-23, and 25-29 are obvious over the '645 application in view of Judge and Hursey for the reasons stated above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 1-15, 21-23, and 25-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of

copending Application No. 10/833,057 in view of U.S. Patent No. 7,096,498 to Judge further in view of U.S. Patent Application Publication No. 2003/0023875 to Hursey et al.

All of the limitations of claim 1 of the instant application are claimed in claim 1 of the '057 application. Claims 2-15, 21-23, and 25-29 are obvious over the '057 application in view of Judge and Hursey for the reasons stated above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

15. Claims 1-14 would be allowable if rewritten or amended to overcome the rejection(s) under the doctrine of double patenting set forth in this Office action.

16. Claim 24 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 1, Though Judge discloses the excluding of nodes from countermeasures, no art could be found that recited to limiting of transmissions to a specific number of hosts as such a countermeasure. Hursey discloses the limiting of

outgoing communications to a number of hosts that exceed a threshold, but this is done on a per transaction basis rather than per unit time (see Hursey, paragraph 33).

Claims 2-14 would be allowable based upon their dependence upon claim 1.

Regarding claim 24, no art could be art found that suggested throttling according to a least requested characteristic.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand, can be reached at (571) 272-3811.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450
Or faxed to:
(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Matthew Heneghan/

July 17, 2007 Patent Examiner (FSA), USPTO Art Unit 2134